THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte BRUCE A. REICHLEN and IVAN E. SUTHERLAND

_____

Appeal No. 1996-3623
Application No. 08/114,546[1]

_____

ON BRIEF

_____

Before THOMAS, FLEMING, and DIXON, **Administrative Patent Judges**.

DIXON, **Administrative Patent Judge**.

DECISION AND REMAND TO THE EXAMINER

This is a decision on appeal from the examiner's final rejection of claims 1-32, which are all of the claims pending in this application.

We REVERSE AND REMAND.

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[1] Application for patent filed Aug. 31, 1993.

BACKGROUND

The appellants' invention relates to a method of displaying information generated by a computer on a display device. An understanding of the invention can be derived from a reading of exemplary claim 1, which can be found in the appendix to the brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Kudo et al.	4,980,765	Dec. 25, 1990
Kaufman (Kaufman '554)	4,987,554	Jan. 22, 1991
Kaufman et al. (Kaufman '475)	5,101,475	Mar. 31, 1992
Travers	5,373,857	Dec. 20, 1994 (Filed Jun. 18, 1993)
Beckman	5,388,990	Feb. 14, 1995 (Filed Apr. 23, 1993)

Kaufman, Arie, et al., "Memory and Processing Architecture for 3D Voxel-Based Imagery," IEEE COMPUTER GRAPHICS & APPLICATIONS, pp. 10-23, 1988. (Kaufman IEEE)

Foley, James D., et al., "Computer Graphics: Principles and Practice", 2nd ed., pp. 860-871, 890-895, Published by Addison-Wesley Publishing Company (PA) (1990). (Foley)

Claims 1-32 stand rejected under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as the invention. Claims 1-3, 6-12, 15-21, 23, and 30-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Beckman in view of Kudo, Kaufman '475,

Kaufman IEEE and Kaufman ‘554. Claims 4, 5 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Beckman in view of Kudo, Kaufman ‘475, Kaufman IEEE, Kaufman ‘554 and Travers. Claims 13, 14 and 24-29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Beckman in view of Kudo, Kaufman ‘475, Kaufman IEEE, Kaufman ‘554 and Foley.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed Feb. 6, 1996) and the supplemental examiner's answer/letter (Paper No. 15, mailed May 20, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants’ brief (Paper No. 12, filed Dec. 15, 1995) and reply brief (Paper No. 14, filed Apr. 10, 1996) for the appellants’ arguments thereagainst.

DISCUSSION

In reaching our decision to remand in this appeal, we have given careful consideration to the appellants’ specification and claims, to the applied prior art references, to the respective positions articulated by the appellants and the examiner and the procedural prosecution history. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 112, SECOND PARAGRAPH

The examiner has rejected claims 1-32 asserting that the claims do not particularly point out and distinctly claim the subject matter which appellants regard as the invention. The examiner generally asserts that the terms "view point" and "frame buffer" are vague and indefinite. The examiner further asserts that each term "contradicts how the term is defined and used in the prior art." (See answer at pages 4 and 5.) Appellants argue that the meaning is clear and not in contradiction to the use in the prior art. We agree with appellants. Analysis of 35 U.S.C. § 112, second paragraph, should begin with the determination of whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. **In re Johnson**, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977) citing **In re Moore**, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (1971). Furthermore, our reviewing court points out that a claim which is of such breadth that it reads on subject matter disclosed in the prior art is rejected under 35 U.S.C. §102

rather than under 35 U.S.C. §112, second paragraph. See **In re Hyatt**, 708 F.2d 712, 715, 218 USPQ 195, 197 (Fed. Cir. 1983) citing **In re Borkowski**, 442 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970). We find that the terms used in the claims when read in light of the specification provide a reasonable degree of precision regarding the metes and bounds of the claimed invention.

The examiner further rejected claim 1 based on the language concerning "storing information related . . ." and stated that "[t]he claim, as drafted, reads on virtually any frame buffer or video memory." (Examiner's answer, page 4.) Clearly, this is an improper application of 35 U.S.C. § 112, second paragraph. The Examiner is arguing the breadth of the claim rather than a deficiency in determining the metes and bounds of the language of the claim.

With respect to claim 12, the Examiner has not set forth a complete statement of the deficiency in the language of the claim. (See answer at page 6.) Therefore, we will not sustain the rejection of claim 12.

With respect to claim 16, the Examiner rejects the claims on a similar basis as claim 1. Similarly, we agree with appellants argument that the meaning of these terms is clear and not in contradiction to the use in the prior art. Since the skilled artisans

would have reasonably understood the metes and bounds of the invention, we will not sustain the rejection of claims 1-32.

35 U.S.C. § 103

Initially, we note that two new grounds of rejection under 35 U.S.C. §§ 102 and 103 over the Regan reference were made in the Examiner's Answer. As a result thereof appellants elected to attempt to antedate the Regan reference rather than to argue the merits of the rejections. Appellants filed two declarations with the Reply Brief, one by each of the inventors, with supporting exhibits, in an attempt to establish conception and reduction to practice prior to the date of publication of the Regan reference.

In the Letter mailed Aug. 20, 1996 the Examiner indicated that these new grounds of rejections were withdrawn and that claims 1-32 remain rejected under 35 U.S.C. § 103 as set forth in the "Office action filed 4/19/95, paper no. 7."[2]

As a result of our review, we note that neither appellants nor the Examiners have addressed the propriety of the remaining rejections under 35 U.S.C. § 103 in light of the established date of invention prior to September 1992. This would appear to effectively

[2] We assume that the Examiner intended to refer to either the final rejection mailed Aug. 28, 1995, paper no. 9 or to the Examiner's Answer mailed Feb. 2, 1996, paper no. 13 since the first Office action, paper no. 7, was not incorporated into the Answer. Furthermore, we assume that the Examiner also intended to maintain the rejection of claims 1-32 under 35 U.S.C. § 112, second paragraph.

antedate the primary reference to Beckman applied against claims 1-32. The Examiner relies upon a filing date of April 23, 1993 for availability of this reference under 35 U.S.C. § 102(e) yet the Examiner indicated that the rejections were maintained. Appellants have not disputed the availability of Beckman as prior art.

Upon return of the application, the Examiner should review the merits of the rejections under 35 U.S.C. § 103 and clarify the position as to why each claim included in the rejection is unpatentable under this section of the statute and state whether Beckman is prior art.

We do not remand this case lightly. We understand that this application has been pending in the Patent and Trademark Office and at this Board for a relatively long length of time. However, the consideration of the evidence of date of invention with respect to the Beckman patent must be addressed prior to any determination by the Board. We emphasize that we have not taken a position on the merits of the matter under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the Examiner to reject claims 1-32 under 35 U.S.C. § 112 is reversed and application is remanded to the Examiner to reconsider the decision of the Examiner to maintain the rejection of claims 1-32 under 35 U.S.C. § 103

and to consider the affidavits under 37 CFR 1.131 with respect to the availability of Beckman as prior art reference under 35 U.S.C. § 102(e) in light of the statement by the Examiner that the declarations were sufficient to antedate the Regan reference and establish conception and reduction to practice prior to September 1992.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(d) (7th Ed. July 1998).

REVERSED AND REMANDED

JAMES D. THOMAS Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

vsh

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